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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/075,874	02/15/2002	Veronica R. Houston	L7064-0001	9423

7590

09/08/2006

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EXAMINER

BORLINGHAUS, JASON M

ART UNIT

PAPER NUMBER

3693

DATE MAILED: 09/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/075,874	Applicant(s) HOUSTON ET AL.	
	Examiner Jason M. Borlinghaus	Art Unit 3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/15/02.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 1-19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 – 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Disclosed Prior Art (specification, pp. 1 – 2) in view of Carroll (Carroll, Jim & Broadhead, Rick. *Selling Online: How to Become a Successful E-Commerce Merchant*. Dearborn Trade. 2001. pp. 379 – 380).

Regarding Claims 1 - 11, Disclosed Prior Art discloses a system for informing a recipient of an investment gift, said system comprising'.

- a financial institution (financial institution, such as an investment firm) offering an investment plan. (see p. 2, lines 15 – 19);
- a recipient (grandchild) receiving the investment plan. (see p. 2, lines 1 – 2);
- an investor (grandparent) contributing to the investment plan for said recipient (grandchild). (see p. 2, lines 1 – 2); and
- an information provider (person giving gift) providing a message (handwritten comment) to said recipient of said investor's contribution to the investment plan. (see p. 2, lines 11 – 14);

- wherein the message (handwritten comment) is a card (conventional card). (see p. 2, lines 11 – 14);
- wherein the message is a voice message generated (verbally inform) by said information provider (person giving the gift). (see p. 2, lines 11 – 14);
- wherein said message includes a textual message (handwritten comment) indicating that said recipient has been given an investment gift from said investor. (see p. 2, lines 11 – 14); and
- wherein said message (conventional card) includes a blank area allowing said investor to transfer personalized information (handwritten comment) to said recipient. (see p. 2, lines 11 – 14).

Disclosed Prior Art does not teach underlined claim limitations – a system

wherein:

- the message is an email message delivered via the Internet;
- said information provider provides a plurality of messages, said investor selecting a message from said plurality of messages for delivery to said recipient;
- said message includes an illustration;
- said information provider provides an electronic message via a web site for selection by said investor, said electronic message being delivered to said recipient from said financial institution to indicate that an investment gift has been given by said investor to said recipient;

- said information provider provides the message to the financial institution for distribution to the recipient; and
- wherein the message includes a specialized gift for said recipient.

Carroll discloses a system wherein:

- the message is an email message delivered via the Internet. (see p. 380);
- said information provider (Illuminations.com) provides a plurality of messages (select an image and message), said investor (customer) selecting a message (select an image and message) from said plurality of messages for delivery to said recipient (family member, family, or colleague). (see p. 379);
- said message includes an illustration (image). (see p. 379);
- said information provider (Illuminations) provides an electronic message (virtual postcard) via a web site (www.illuminations.com) for selection by said investor (customer), said electronic message (virtual postcard) being delivered to said recipient. (see p. 379).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Disclosed Prior Art by incorporating an online and/or electronic message system, as disclosed by Carroll, into the notification system for recipients of an investment fund gift, allowing for automation of a previously manual notification system.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Disclosed Prior Art and Carroll to allow for any

party to the transaction to distribute the message that the inventor desired, such as the investor, the information provider or the financial institution. *In re Kuhle*, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975).

Provision of a specialized gift for a recipient to be delivered with the message, such as money inserted in a birthday card or a balloon sent along with a "get well" card, is old and well known in the art of communication and gifting. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Disclosed Prior Art and Carroll to incorporate the provision of a specialized gift for a recipient with the delivered message, as such provision of a specialized gift is conventional and/or standard in sending such messages.

Regarding Claims 12 - 19, Claims 12 – 19 recite similar limitations and/or would have been obvious based upon Claims 1 - 11 rejected above, and are therefore rejected using the same art and rationale as applied in the rejection of Claims 1 - 11.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Borlinghaus whose telephone number is (571) 272-6924. The examiner can normally be reached on 8:30am-5:00pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3693

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



ELLA COLBERT
PRIMARY EXAMINER